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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,874	01/05/2001	Jun Liu	MSI-710US	4083

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LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

EXAMINER

GROSS, KENNETH A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 02/12/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,874

Applicant(s)

LIU ET AL.

Examiner

Kenneth A Gross

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 27 makes reference to the system of Claim 1, yet Claim 1 is a method claim. It is understood that Claim 27 should be dependent on Claim 22, and is being interpreted as such.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al. (U.S. Patent Number 5,519,869) in view of Lerche (U.S. Patent Number 6,457,175).

In regard to Claim 1, Payne teaches identifying essential software within a device, the essential software including software necessary to operate the device (Column 4, lines 32-34);

(b) identifying remaining portions of software within the device as non-essential software

(Column 4, lines 40-42); (c) downloading new essential software from an external source to the

Art Unit: 2122

device and storing the new essential software in memory (Column 6, lines 18-24 and Figure 4, item 46). Payne does not teach that essential software includes software necessary to provide external communications. Lerche, however, does teach a software image that allows a computer to boot including software to provide external communications (Column 3, lines 41-45). Neither Payne nor Lerche specifically teach when saving essential software, overwriting at least a portion of the non-essential software. However, if memory were limited, it would be obvious to overwrite certain non-essential software when installing essential software, since this would create enough space to install the essential software. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of identifying essential software within a device, identifying non-essential software, and downloading new essential software from an external source to the device and storing the new essential software in memory, as taught by Payne, where essential software includes software necessary to provide external communications, as taught by Lerche, since this allows the computer to be placed in a state that allows it to talk to a network, and hence fully functional in a corporate networked environment, and finally when saving essential software, overwriting at least a portion of the non-essential software, since in the case of limited memory, this would obviously provide enough room for the essential software to be installed.

In regard to Claim 2, Lerche teaches that after downloading the new essential software, attempting to operate the device and provide external communications using the new essential software (Column 9, lines 31-46).

In regard to Claim 3, Payne teaches that upon successfully operating the device and providing external communications, selectively downloading new non-essential software

(Column 4, lines 6-11). Payne does not teach overwriting at least a portion of either the essential software or the non-essential software. Lerche, however, does teach overwriting old non-essential software when downloading new non-essential software (Figure 6A, item 110). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to selectively download new non-essential software, as taught by Payne, where, when storing the software, overwriting non-essential software, as taught by Lerche, since more updated software that performs better than old software usually replaces old software.

In regard to Claim 4, Payne teaches I/O Control Units (Figure 1, items 18-22), which allow a user to control the computer, and hence the computer is managed through these I/O units.

In regard to Claim 5, Lerche teaches the external source includes a server device (Figure 1, item 26).

In regard to Claim 6, Lerche teaches that the external source includes a network (Figure 1, item 32).

In regard to Claim 7, Lerche teaches that the network includes the Internet (Column 2, lines 38-40).

In regard to Claim 8, Lerche teaches that the essential software comprises an operating system and communications software (Column 4, lines 27-32).

Claims 9-16 are medium claims that correspond to method claims 1-8, respectively, and are rejected for the same reasons as Claim 1-8, respectively, where Lerche teaches a medium for carrying out said method of Claims 1-8 (Column 12, lines 50-62).

Claims 17-21 are apparatus Claims that correspond to method Claims 1-4 and 8, respectively, and are rejected for the same reasons as Claims 1-4 and 8, where Payne teaches an apparatus for carrying out said method of Claim 1-4 and 8 (Figure 1).

Claim 22 is a system claim that contains limitations that have already been addressed in the rejections of Claims 1, 5, and 6, and Claim 22 is rejected for the same reasons as these Claims, where Lerche teaches a system for carrying out said method of Claims 1, 5, and 6 (Figure 1).

Claims 23-27 are system Claims that correspond to Claims 2-4, 7, and 8, respectively, and Claims 23-27 are rejected for the same reasons as these Claims, respectively, where Lerche teaches a system for carrying out said method of Claims 2-4, 7, and 8 (Figure 1).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2122

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KAG



TUAN DAM
SUPERVISORY PATENT EXAMINER